

Appln No09/575,182
Amdt. Dated October 13, 2003
Reply to Office action of May 23, 2003

5

REMARKS/ARGUMENTS

The Applicant notes that the only pending rejections are based on 35 USC 103(a). The Applicant now proposed amendments to claim 1 and certain dependent claims. The claims as amended clearly distinguish the invention from the prior art.

Please enter the amended claims as attached to this response in favor of the pending claims.

The examiner objects to the claims under 35 USC 103(a). The initial burden is on the Examiner to show that the features recited in the claims are first and foremost present in the cited references and that there is some motive, suggestion or teaching in the cited art for making the invention which is (without any contrary suggestion by the examiner) first disclosed by the Applicant.

According to the MPEP 706.02(j) the Examiner's 103 rejection is obliged to consider the differences in the claim over the applied references, the proposed modification of the applied references necessary to arrive at the claimed subject matter, and an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

Accordingly, the Examiner is obliged to consider these features of claim 1, now paraphrased, which are not found in ANY of the cited art references:

- an elongate body having a longitudinal axis with a stationary printhead housed within said body. (Kokubo has an elongated body, but the printhead is not "within" it.)
- the body having two opposing slots, the slots being parallel to the longitudinal axis and interconnected by a paper path which passes through the body;
- powered rollers for moving a printable media through the paper path and past said stationary printhead;

Appln No09/575,182
Amdt. Dated October 13, 2003
Reply to Office action of May 23, 2003

6

MPEP 706.02(j) also demands that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

In the present case the Examiner has not provided any motivation or suggestion for the combinations made in the previous Office Action. The Examiner suggests that the references are from analogous arts. This may indicate that references can be physically combined but provides no proof or indicator of motivation or suggestion which can be seen as other than hindsight reconstruction.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. He has not. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Appln No09/575,182
Amdt. Dated October 13, 2003
Reply to Office action of May 23, 2003

7

Conclusion

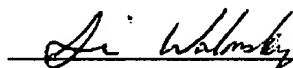
With all due respect, the Examiner has not carried the burden on the issue of obviousness under 35 USC 103. Claim amendments have been provided to even further distinguish the invention from the cited art. Favorable reconsideration is requested.

Very respectfully,

Applicant:



KIA SILVERBROOK



SIMON ROBERT WALMSLEY

**RECEIVED
CENTRAL FAX CENTER**

OCT 16 2003

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

OFFICIAL

Email: kia.silverbrook@silverbrookresearch.com
Telephone: +612 9818 6633
Facsimile: +61 2 9555 7762